

REMARKS

In the January 20, 2004 Office Action, the Examiner rejected claims 1-16 and 19-46 pending in the application. Claims 1-16 and 19-50 (5 independent claims; 48 total claims) remain pending in the application. Applicants request reconsideration in view of the following remarks.

Claims 1-16, and 19-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosen, U.S. Patent No. 6,336,095, issued January 1, 2002 (hereinafter "Rosen") in view of Wang, U.S. Patent Application Publication No. US 2002/0082929 A1 (hereinafter "Wang"). Applicants respectfully traverse this rejection and provide the following arguments in support. Applicants note that the Examiner fails to discuss claims 47-50 in the Office Action.

In general, Rosen is limited to a system for secure open electronic commerce between a customer and a merchant. Rosen discloses that a customer trusted agent securely communicates with a first money module, and a merchant trusted agent securely communicates with a second money module. The merchant trusted agent transfers electronic merchandise to the customer trusted agent, and the first money module transfers electronic money to the second money module. The "trusted agents" are "a combination of hardware and software components." Rosen further provides that "trusted agents" are "tamper-proof and contain[s] secure protocols which cooperate with a money module 6 to synchronize secure payment to deliver." The trusted agents are surrogate actors for an entity who wants to transact remotely (electronically) in a secure way. The trusted agents are "under control of transaction protocols and behave in a way calculated to resolve the transaction to the satisfaction of both parties." Most notably, the trusted agents exchange **electronic merchandise** and payment. (column 4, lines 9-38).

In particular, if a customer is dissatisfied with a purchase, Rosen provides for **remote** resolution of the dispute between the **customer** and **merchant**. (see Column 28, line 42 - column 30, line 47). During such a dispute, Rosen provides that the trusted agents can act as surrogates for the customer and merchant. First, the customer can connect to the merchant and enter into a dispute dialogue (col. 28, lines 45-48). During the dispute dialog, transaction logs are displayed to facilitate the identification of the

disputed transaction. In addition, the customer can enter a description of the problem. (see Figure 30A, col. 28, lines 50-55 and col. 29, lines 5-29) However, as stated by the Examiner, Rosen does not provide for displaying a pre-defined set of a plurality of available dispute handling forms having pre-defined content. Instead, Rosen displays a transaction log to facilitate the "choice" of the transaction that is to be disputed (see steps 1056 and 1060 in Figure 30A) and Rosen allows the customer/owner to describe the problem (see step 1060 in Figure 30A) . The transaction "choice" and the description of problem are sent between the customer and merchant, and/or their trusted agents, as the "dispute information" (see Figures 30A-30E, col. 29, lines 15-19).

If the customer is not satisfied with the result of the dispute interaction with the merchant, the customer can take his complaint to the "Trusted Agency" (col. 28, lines 52-54). The dispute and accompanying documentation can then be presented to a trusted server on the Trusted Agency Network.

Wang generally discloses a digital evidence system for recording pertinent screen activities such as data entry into an electronic form. The Wang system is used to facilitate online transactions between a provider and a buyer (see Paragraph 025). An online transaction module 204 is used to capture text information entered by the buyer. In addition, a digital evidence module 206 is used to capture an entire screen display or one or more displayed windows in the display screen of the user (see Paragraphs 0032-0035).

On Page 2 of the Office Action, the Examiner states that "Rosen fails to teach an inventive concept of displayed form comprises a pre-defined set of available forms that are available only to the issuers. However, Wang et al teach inventive concept of displayed form comprises a pre-defined set of available forms that are available only to the issuers (see *paragraphs 0008, 0023-0026, 0032-0035*).” Applicants disagree with the Examiner’s characterization of Wang. A detailed review of the paragraphs specified by the Examiner and a detailed review of the entire published application of Wang fails to reveal any disclosure or suggestion of “a pre-defined set of available forms that are available only to the issuers.” The Wang system is used to capture data entered by a user (either a buyer or a provider) and the Wang system is used to capture entire or partial screen shots of an online transaction as “digital evidence”, so that the “digital

evidence" is preserved for later use as necessary (see, *inter alia*, paragraphs 0032-0035).

In contrast to Rosen and Wang, the presently claimed invention provides for a significantly different system and method that **facilitates "communication between an Issuer and an Acquirer in the context of resolving a post-transactional dispute"** between the Issuer and the Acquirer. **The present invention does not involve the customer, and particularly, does not involve a customer's communication with a merchant or a buyer's communication with a provider.** An Acquirer is an entity that markets, installs, and supports POS transaction card acceptance at service establishments, and typically negotiates a contract with the service establishment to accept certain brands of cards. An Issuer is typically a bank or other financial institution that is typically operating under regulations of a card issuing association or entity and which issues cards to cardmembers under a cardmember agreement for a cardmember account. Thus, an Issuer and Acquirer are clearly not equivalent to a customer or merchant as provided by Rosen or a buyer or provider as provided by Wang. Furthermore, the presently claimed invention does not provide for a system or method that includes trusted agents, electronic merchandise, or that provides for participation by a customer/buyer or merchant/provider in the dispute resolution. For example, when a post-transaction dispute arises between an Issuer and an Acquirer, the presently claimed invention provides for a system and method that displays, to the Issuer, a pre-defined set of available forms that are available **only** to the Issuer. The Issuer selects one of the available forms and completes the selected form. The Issuer then sends the form to the Acquirer who views the form. The Acquirer then selects a form from a display of a pre-defined set of forms that are available **only** to the Acquirer and also completes the selected form. This process may be repeated for a number of forms.

Rosen and Wang fail to teach, suggest or disclose such a system. In particular, Rosen and Wang fail to teach, suggest or disclose "facilitating communication between an Issuer and an Acquirer in the context of resolving a dispute" as claimed by Applicants, because it is not the intention of Rosen or Wang to resolve disputes between an Issuer and an Acquirer. Rather, Rosen teaches resolving disputes between a customer and merchant, including the examination and/or return of electronic

merchandise, and Wang teaches capturing digital evidence to facilitate transactions between providers and buyers. The systems taught by Rosen and Wang could not be used by Issuers and Acquirers. For example, Rosen provides for the return of electronic merchandise (Figures 30A-30E, column 28, line 42 - column 30, line 47), and an Issuer or Acquirer would not have access to the electronic merchandise.

Applicants' independent claim 1 (and independent claims 7, 15, 23 and 33) recites a system "for **facilitating communication between an Issuer and an Acquirer** in the context of resolving a post-transactional dispute, wherein **the dispute is between the Issuer and the Acquirer** and the dispute is related to an executed credit transaction between a cardmember and a service establishment." (emphasis added) In addition, Applicants' independent claim 1 (and independent claims 7, 15, 23 and 33) recites "displaying available dispute handling forms having pre-defined content, said forms retrieved from said server, wherein said displayed forms comprises a pre-defined set of said available forms that are **available only to Issuers**, wherein the Issuer selects a particular one of the available forms utilizing said input means" (emphasis added) As previously discussed above, Rosen and Wang disclose systems for use by customers/buyers and merchants/providers that are not systems for facilitating communication during a post-transactional dispute between Issuers and Acquirers. In addition, Rosen and Wang fail to disclose, teach or suggest, *inter alia*, "displaying available dispute handling forms", "wherein said displayed forms comprises a pre-defined set of said available forms that are **available only to Issuers**". Instead, Rosen teaches the display of transactions logs and dispute information entered by the customer (see FIGS. 30A, col. 28, lines 50-55 and col. 29, lines 5-29) and Wang simply teaches capturing an entire screen display (or portions) that contains text entered by the user (see Paragraphs 0032-0035).

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP 2143.03 citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). With respect to dependent claims 2-6, 8-14, 16, 19-22, 24-32 and 34-50, as stated above, Applicants submit that all of the elements of the underlying independent claims 1, 7, 15, 23 and 33 are not present in the

cited references either alone or in combination, and therefore are not present in claims 2-6, 8-14, 16, 19-22, 24-32 and 34-50.

In addition, as stated in MPEP 2141, "the examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." (emphasis added) In order to establish a prima facie case of obviousness, "there must be some suggestion, teaching or motivation to modify the reference or combine the references on which the rejection is based." MPEP 2142. It is well established that "[t]he presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact." In re Gartside, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000). Accordingly, Office Actions rejecting claims for obviousness must be supported by evidence. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); emphasis added.

Moreover, the evidence on which an obviousness rejection is based must be set forth in the Office Action. As stated in MPEP 2144.08 III, "Explicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection.... Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings." Therefore, Applicants assert that there is no motivation to combine the Rosen and Wang references.

For the reasons stated above, Applicants respectfully request the withdrawal of the Section 103 rejection with respect to claims 1-17 and 19-46.

In addition, previously added claims 47-50 recite displaying a set of forms available only to Issuers wherein the displayed forms comprise "a retrieval request form, a first chargeback form, and a final chargeback form." Rosen and Wang fail to disclose or suggest "a retrieval request form, a first chargeback form, and a final chargeback form" as recited by dependent claims 47-50. Therefore, previously added claims 47-50 are also patentable over Rosen in view of Wang.

CONCLUSION

In view of the foregoing, Applicants respectfully submit that all of the pending claims, namely 1-16 and 19-50, fully comply with 35 U.S.C §112 and are allowable over the art of record. Reconsideration of the application is respectfully requested. Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, then the Examiner is invited to contact the undersigned at the Examiner's convenience.

Date: 20-April-2004

Respectfully submitted,

By: David O. Caplan
David O. Caplan
Reg. No. 41,655

SNELL & WILMER, LLP.
One Arizona Center
400 East Van Buren
Phoenix, AZ 85004-2202
Direct: (602) 382-6284
Fax: (602) 382-6070
Email: dcaplan@swlaw.com